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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) ITC-331US	
	Application Number 10/529,161	Filed February 27, 2006
	First Named Inventor Christian Mueller	
	Art Unit 3745	Examiner Frank D. Lopez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.

See 37 CFR 3.7.1 Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/88)

☒ attorney or agent of record.

Registration number **34,515**

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Lawrence E. Ashery

Typed or printed name

610-407-0700

Telephone number

May 21, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 5 forms are submitted

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Claims 1-24 have been rejected under 35 U.S.C. § 112, second paragraph. In particular, various claims are identified in the Official Action and (a) an explanation is given as to why there is a problem with the claim language; and/or (b) suggested language for amending the claim is provided. Applicants have followed most of the suggestions of the Official Action, with the exception of claim 11 which recites that an external force can be applied to adjust the desired position of the test head. The step of applying external force is a step which is distinctive from the steps included in claim 9. Reconsideration of the rejection of that claim is respectfully requested. Withdrawal of the rejections of the remaining claims is respectfully requested as all other issues specified by the outstanding Official Action have been addressed.

Before providing the substance of Appellant's argument with regard to the prior art, Appellant wishes to respond to the Advisory Action. In the Advisory Action, the Examiner points out that there are two different rejections using Slocum.

Regarding the first rejection using Slocum, the Examiner does not provide any argument in the Advisory Action to explain why the first rejection is improper.

Regarding the second rejection using Slocum, the Examiner states in the Advisory Action:

Even if the rejection which "rotates the second embodiment 180 degrees" is improper and withdrawn, the other rejection using Slocum is still applicable and therefore the claims are still rejected.

The Examiner further points out that the second rejection is based on a second embodiment with a drive mechanism at the top of the positioning apparatus and a first embodiment "in an order that is 180 degrees rotated from the order of the second embodiment." The Examiner then makes a conclusory statement: one of ordinary skill would recognize that the lifting device can be orientated in either orientation and would understand how to disconnect the cavity from the base and attach it to an element at the top of the apparatus. As such, the modified second embodiment would be operative ...

While Slocum indeed shows different embodiments, the statement in the Advisory Action that "one of ordinary skill ... would understand how to disconnect the cavity ... and attach it ..." is not a proper basis of rejection. In fact, Appellant

completely disagrees with the above statement. It is a basic requirement of KSR case law that there must be an "articulated reasoning with some rational underpinning to support the legal conclusion" of obviousness. In the Advisory Action, there is no articulated reasoning. In the Advisory Action there is no rational underpinning. The second rejection is based on two different embodiments which are disclosed in the Slocum patent. Why would one of ordinary skill in the art modify Slocums' embodiments as proposed by the Examiner? What is the reason? Why would an engineer take Slocums' allegedly functional positioner systems and start making changes to them. Appellant has intentionally claimed "a variable size fluid compartment within said first member" and "said first member is at least partially above and moves relative to said second member." The synergy of these features is to provide fine tuning adjustment of the vertical position of a test head in a simple manner without excessive force. Thus, the first member can be raised without moving the second member to fine tune the position of the test head. Slocum lacks Appellant's claimed features and can not function in the manner that Appellant's claimed features function. Accordingly, Appellant's claims are patentable over the art of record.

Claims 1-17 and 19-21 have been rejected under 35 U.S.C. § 103 as being obvious over Slocum. Basically, the rejection is formulated by (a) adding the second Slocum embodiment to the first Slocum embodiment; and (b) rotating the second Slocum embodiment by 180°. The rejection is respectfully traversed. In traversing the rejection, Applicants rely on MPEP 2141:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *in re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness.'" *KSR*, 550 U.S. at ____,
82 USPQ2d at 1396

The Official Action has modified Slocum's second embodiment, but has not provided the requisite "articulated reasoning with some rational underpinning." Absent articulated reasoning for rotating this second embodiment 180°, the rejection is improper and should be withdrawn.

In addition, while the Official Action structures the rejection by rotating the second embodiment 180°, the modification to the second embodiment destroys the functionality of the device. Slocum's second embodiment includes a cavity 474 which is secured to base plate 404. If Slocum's second embodiment is rotated as the Official Action has suggested, cavity 472 would no longer be secured to base 404. In that case, it is not understood how Slocum's modified second embodiment would operate, as the cavity would no longer be secure to the base. Thus, the rejection is traversed because the alleged modification renders the second embodiment inoperable. There is a case law that states that references can not be modified in a way that destroys the functionality of the device which is being modified.

Furthermore, because of the lack of detail regarding what the modified embodiment would look like, the rejection is incomplete. Applicants are unable to fully respond to the Official Action because they do not have a clear picture of how the rejection has been formulated. Claims 1-17 and 19-21 have been rejected under 35 U.S.C. § 103 as obvious over Slocum. This is a separate rejection. In particular, the rejection states:

Therefore, it would have been obvious at the time the invention was made to one having ordinary skill in the art to orient the second embodiment of Slocum et al., such that the drive mechanism is at the bottom of the positioning apparatus, as taught by the first embodiment of Slocum et al., since one having ordinary skill in the art would have been able to carry out such a reorientation and the resulting combination would predictably work in the same manner.

Again, the rejection is traversed because Applicants do not understand how the second embodiment can be “flipped over” as described in the Official Action. As the second embodiment relies on the cavity attached to the base in order to function, the second embodiment will no longer be able to operate when the cavity and the base are detached. Furthermore, Applicants do not have a clear understanding of how the second embodiment could be flipped over and hence are unable to properly analyze the modification suggested by the Official Action. Third, KSR requires articulated reasons with rational underpinning, and without the mirror use of conclusory statements. The rationale provided in the Official Action is that one of ordinary skill would flip over Slocum because of one of ordinary skill in the art could reorient Slocum. This is not an articulated reason with rational underpinning. Furthermore, the Official Action’s logic that “such a reorientation and the result combination would predictably work in the same manner” is traversed because Applicants have no basis to determine whether, indeed, the resulting combination would predictably work in the same manner (if at all).

Allowance of the above-identified application is respectfully requested.